



UTILITY PATENT APPLICATION  
Atty. Docket No. 87157656-002004

# 6

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

In re Application of: Linkai Bu *et al.*  
Serial No.: 09/765,966  
Filed: January 19, 2001  
For: DYANAMIC CMOS LEVEL-SHIFTING CIRCUIT APPARATUS

Group Art Unit: Not yet assigned

Examiner: Not yet assigned

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450  
Attn Mail Stop: Petitions

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December 29, 2003

**PETITION UNDER 37 C.F.R. 1.181**

In response to the Notice of Abandonment mailed October 27, 2003, in the present Application, the Applicant respectfully submits this Petition to Withdraw Holding of Abandonment under 37 C.F.R. § 1.181.

**CERTIFICATE OF EXPRESS MAIL – EV417296549US**

I hereby certify that this correspondence is being deposited with sufficient postage in the U.S. Mail, Express Mail Service, addressed to:

Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450  
Attn Mail Stop: Petitions

Date of Mailing: December 29, 2003

Signature:

*Brian C. McCormack*

Brian C. McCormack

**I. PETITION TO WITHDRAW NOTICE OF ABANDONMENT UNDER 37 C.F.R. 1.181**

The Applicant respectfully requests that this Petition to Withdraw Holding of Abandonment under 37 C.F.R. § 1.181 (this "Petition") be granted and that the Notice of Abandonment in the present Application be withdrawn. The Manual of Patent Examining Procedure (M.P.E.P.) provides that if an application is improperly abandoned, the holding of abandonment may be withdrawn upon petition:

Where an applicant contends that the application is not in fact abandoned . . . a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate cause of action, and such petition does not require a fee.

M.P.E.P. § 711.03(c). Based upon the following evidence, the Applicant respectfully submits that the present Application was improperly abandoned.

A Notice to File Missing Parts (the "Notice") was allegedly mailed on the present Application on February 27, 2001. However, the Applicant respectfully submits that the Notice was never received by the Applicant at the Correspondence Address designated in the present Application. Rather, according to our review of the prosecution history in this case, the Notice was addressed to Chi Mei Optoelectronics Corporation ("Chi Mei") and was never received by Applicant's attorneys. Consequently, no reply was filed before the Notice response deadline and the present Application became abandoned on October 27, 2003, thirty-two (32) months from the mailing date of the Notice. A Notice of Abandonment Under 37 CFR § 1.53(f) or (g) was mailed October 27, 2003. This Petition is being filed within the two-month response period set forth in 37 C.F.R. § 1.181(f). In addition, it is believed that no fees for this Petition are due. M.P.E.P. 711.03(c).

As stated above, the Notice was addressed to Chi Mei rather than the Correspondence Address designated in the present Application. While Chi Mei is the client of Baker &

McKenzie and was an intended assignee of the present Application, no assignment from the inventors to Chi Mei was ever filed with the United States Patent and Trademark Office ("USPTO"). On the original transmittal sheet for the filing of the present Application (EXHIBIT A TO DECLARATION OF ANTOINETTE F. KONSKI), the designated Correspondence Address for the present Application was the Palo Alto office of Baker & McKenzie. The client's Taipei address was only shown as an address for the "Applicant" on an unofficial data sheet submitted with the filing. It should be noted that the transmittal sheet does not have a check in the checkbox for the official Application Data Sheet according to 37 CFR § 1.76. Rather, the only indication of the inclusion of a data sheet is reflected under part 16 of the heading "Accompanying Application Parts." Furthermore, the data sheet that was included in the present Application does not comply with the requirements of 37 CFR §1.76 and, therefore, should not have been designated the official Application Data Sheet.

In support of the above, a Declaration of Antoinette F. Konski, a previous attorney in the Palo Alto office of Baker & McKenzie, the designated Correspondence Address for the present Application at the time the application was filed and the Notice was mailed, is attached (EXHIBIT B). Ms. Konski states that the Palo Alto never received the Notice dated February 27, 2001 (Konski Decl. ¶10). Additionally, a Declaration of June Lee, a former Patent Administrator in the Taipei office of Baker & McKenzie, is attached (EXHIBIT A), wherein Ms. Lee states that in the normal course of her work she received correspondence from the Palo Alto office on certain patent related matters on which the Palo Alto office was the designated Correspondence Address, including matters that are being handled for clients of the Taipei office, such as the present Application (Lee Decl. ¶4). Ms. Lee further states that to the best of her knowledge, the Taipei office also did not receive the Notice, either from the Palo Alto office

or the client, Chi Mei (Lee Decl. ¶5). Furthermore, a Declaration of Gerald Lin, a Patent Engineer in the Taipei office of Baker & McKenzie, is attached (EXHIBIT C), wherein Mr. Lin states that he has searched the file jacket of the present Application and was unable to locate a copy of the Notice, which indicates that the Notice was not received by the Taipei office (Lin Decl. ¶4).

The M.P.E.P. further states that:

The showing required to establish the nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

M.P.E.P. 711.03(c). A copy of the docket records of the Palo Alto office of Baker & McKenzie where a response to the non-received Notice would have been entered if the Notice was received (EXHIBIT B TO DECLARATION OF ANTOINETTE F. KONSKI) is attached to and referenced in Ms. Konski's Declaration (Konski Decl. ¶10). The attached docket records illustrate all of the matters docketed for action from January 19, 2001 to July 19, 2002, and illustrates the absence of a docketed response deadline to the Notice during this period. Specifically, the attached docket records for the present Application illustrate all of the matters docketed for action on April 27, 2001, the end of the two-month period for response to the Notice mailed February 27, 2001, and illustrate the absence of a docketed response deadline to the Notice on that date.

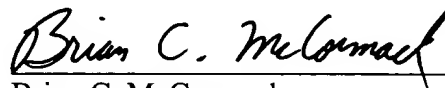
In addition, the Declaration of Brian C. McCormack, a registered patent attorney (Reg. No. 36,601) in the Dallas office of Baker & McKenzie, is also attached (EXHIBIT D). The Declaration of Brian McCormack sets forth numerous facts establishing that the Applicant has diligently pursued the preparation and filing of this Petition in order to the revive of the present Application. Accordingly, Applicant respectfully requests the holding of abandonment be withdrawn in the present Application based on the failure to receive the Notice dated February 27, 2001.

## II. CONCLUSION

In view of the foregoing, the Applicants respectfully request the present Application be revived in response to this Petition. Although no fees are believed to be due with the present Petition, authorization is hereby given to charge any necessary fees that may be required to Deposit Account No. 13-0480, referencing Attorney Docket No. 87157656-002004. The Applicant respectfully requests the undersigned Attorney of Record be contacted with regard to any questions or concerns regarding the present Petition.

Respectfully submitted,

Date: December 29, 2003



Brian C. McCormack  
Reg. No. 36,601  
Attorney for Applicant

**BAKER & McKENZIE**  
2300 Trammell Crow Center  
2001 Ross Avenue  
Dallas, TX 75201  
Tel: (214) 978-3000  
Fax: (214) 978-3099



## EXHIBIT A

### DECLARATION OF JUNE LEE

I, June Lee, a citizen of the R.O.C. and residing at 8F, No. 12, Lane 28, Long An Rd, Shiji, Taipei County, Taiwan, R.O.C. declare:

1. My name is June Lee and I am over the age of twenty-one (21) years, of sound mind, and fully competent to testify to the following facts. I have personal knowledge that all facts set forth in this Declaration are true and correct.
2. I was the former Patent Administrator in the Taipei office of Baker & McKenzie, which has an address of 15<sup>th</sup> Floor, Hung Tai Center, No. 168, Tun Hwa North Road, Taipei, Taiwan 105.
3. The Palo Alto office of Baker & McKenzie, which has an address of 660 Hansen Way, Palo Alto, California 94304, was the designated Correspondence Address for U.S. Patent Application No. 09/765,966 (the "Application"), on February 27, 2001, the mailing date set forth in the Notice to File Missing Parts issued for the Application.
4. In the normal course of my work while I was a Patent Administrator in the Taipei office of Baker & McKenzie, I received correspondence on patent related matters handled by Taipei Office, but on which the Palo Alto office was the designated Correspondence Address.
5. While I as a Patent Administrator in the Taipei office of Baker & McKenzie, I did not receive a Notice to File Missing Parts dated February 27, 2001, issued by the United States Patent and Trademark Office from the Palo Alto Office.
6. I further declare that all statements made herein of my own personal knowledge are true, and all statements made on information are believed to be true; and furthermore, that the

UBLIC  
S. LEE

statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code.

June Lee  
June Lee

SUBSCRIBED AND SWORN TO BEFORE ME on this 23 day of December 2003, to certify which witness my hand and seal of office.

My Commission Expires:

December 31, 2011

\_\_\_\_\_  
Notary Public in and for the

State of Taiwan, Republic of China

John Lee

Printed Name of Notary

\_\_\_\_\_  
Printed Name of Notary

案號	日期
Case No. 00129	Date DEC 23 2003
本文件之簽名或蓋章，於台灣台北地方法院民間公證人處認證。	
Attested at the Notary Public of Taiwan Taipei District Court, R.O.C. that the signature(s)/seal(s) in this document is/are authentic.	
Notary Public	<u>John S. Lee</u>
公證人	李忠雄
	LEEJOHN-SHIUNG



## EXHIBIT B

### DECLARATION OF ANTOINETTE F. KONSKI

I, Antoinette F. Konski, a citizen of the United States and residing at 2161 Sharon Road, Menlo Park, CA 94025, USA, declare:

1. My name is Antoinette F. Konski and I am over the age of twenty-one (21) years, of sound mind, and fully competent to declare as follows. I have personal knowledge that all facts set forth in this Declaration are true and correct.

2. I was a patent attorney (Reg. No. 34,202) in the Palo Alto office of Baker & McKenzie, which has an address of 660 Hansen Way, Palo Alto, California 94304, from May 17, 1999 to June 7, 2001, and I was the responsible partner for patent matters being handled from that office.

3. I have reviewed the United States Patent & Trademark Office's (USPTO's) prosecution history for U.S. Patent Application No. 09/765,966 (the "Application"), and my review of the prosecution history refreshed my recollection and was consistent with my knowledge of the facts as set forth below.

4. On January 19, 2001, I filed the Application on behalf of Baker & McKenzie's local Taipei, Taiwan office client, Chi Mei Optoelectronics Corporation. For the purposes of communication, all correspondence from the U.S. Patent Office received by me in the local Palo Alto office was forwarded to the Baker & McKenzie Taipei office after entry into our patent docketing database.



5. On the original transmittal sheet for the filing of this application, which is attached as Exhibit A to this declaration ("Transmittal"), the designated Correspondence Address for the Application was Baker & McKenzie's Palo Alto office, designated for my attention.

6. According to the Application's prosecution history, a Notice to File Missing Parts in this Application was mailed by the USPTO on February 27, 2001, but it was mailed to the client's Taipei address, which was only shown as an address for the "Applicant" on an unofficial data sheet submitted with the filing. The Transmittal does not have a check in its checkbox provided for indicating the enclosure of an official Application Data Sheet (37 C.F.R. § 1.75).

7. In the normal course of my work while I was an attorney in the Palo Alto office of Baker & McKenzie, I received correspondence on patent-related matters for which the Palo Alto office was the designated Correspondence Address.

8. In the normal course of my work, I forwarded correspondence I received on patent related applications filed on behalf of the local Taipei, Taiwan office of Baker & McKenzie, which has an address of 15<sup>th</sup> Floor, Hung Tai Center, No. 168, Tun Hwa North Road, Taipei, Taiwan 105, when the matters originated in the Taipei office.

9. While I was an attorney in the Palo Alto office of Baker & McKenzie, it was our normal procedure to enter all USPTO filings into the docketing system so that a docket report of actions due for such matters could be generated from the docketing system.

10. As designated in the attached docket listing of Exhibit B for the relevant period, I did not receive the Notice to File Missing Parts dated February 27, 2001, from the USPTO.

11. I further declare that all statements made herein of my own personal knowledge are true, and all statements made on information are believed to be true; and furthermore, that the statements were made with the knowledge that willful, false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code.

Antoinette F. Konski

Antoinette F. Konski

SUBSCRIBED AND SWORN TO BEFORE ME on this 18th day of December 2003, to certify which witness my hand and seal of office.

My Commission Expires:

July 24, 2005

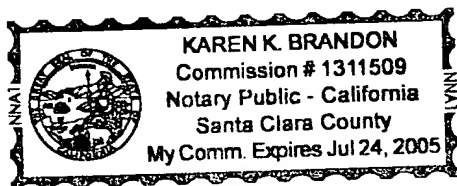
Karen K. Brandon

Notary Public in and for the

State of California

Karen K. Brandon

Printed Name of Notary



## EXHIBIT A TO DECLARATION OF ANTOINETTE F. KONSKI

01-22-01

A

1c96 U.S. PTO  
01/19/01Please type a plus sign (+) inside this box → ☒

PTO/SB/05 (08-00)

Approved for use through 10/31/2002. OMB 0631-0032  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.UTILITY  
PATENT APPLICATION  
TRANSMITTAL

Attorney Docket No. 141181-002004

First Inventor or Application Identifier LINKAJ BU

Title DYNAMIC CMOS LEVEL-SHIFTING CIRCUIT APPARATUS

Express Mail Label No. EL561390025US

(Only for new nonprovisional applications under 37 C.F.R. § 1.53(b))

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning design patent application contents.

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)  
Applicant claims small entity status.  
See 37 CFR 1.27.
2. ☐ Specification (Total Pages )  
(Preferred arrangement set forth below)  
- Descriptive title of the invention  
- Cross References to Related Applications  
- Statement Regarding Fed sponsored R & D  
- Background of the invention  
- Brief Summary of the invention  
- Brief Description of the Drawings (if filed)  
- Detailed Description  
- Claim(s)  
- Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C.113) (Total Sheets )
5. Oath or Declaration (Total Pages )  
a. ☐ Newly executed (original or copy)  
b. ☐ Copy from a prior application (37 CFR 1.63 (d))  
(for a continuation/divisional with Box 17 completed)  
c. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s)  
named in the prior application, see 37 CFR  
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

## ADDRESS TO

Assistant Commissioner for Patents  
Box Patent Application  
Washington, DC 20231

7. ☐ CD-ROM or CD-R in duplicate, large table or  
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission  
(if applicable, all necessary)  
a. ☐ Computer Readable Form (CRF)  
b. Specification Sequence Listing on:  
i. ☐ CD-ROM or CD-R (2 copies); or  
ii. ☐ paper  
c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATIONS PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 C.F.R. § 3.73(b) Statement of Power of Attorney  
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449  
☐ Copies of IDS Citations
13. ☐ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
16. ☒ Other: Data Sheet

17. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment,  
or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No. \_\_\_\_\_ / \_\_\_\_\_  
Prior application information: Examiner \_\_\_\_\_ Group / Art Unit: \_\_\_\_\_

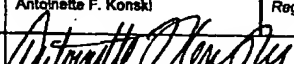
For CONTINUATION or DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied  
under Box 5b, is considered a part of the disclosure of the accompanying or divisional application and is hereby incorporated by reference.  
The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 17. CONTINUING APPLICATION ADDRESS

☒ Customer Number or Bar Code Label

022836

or ☐ Correspondence address below

Name	Antoinette F. Konski				
	Baker & McKenzie				
Address	660 Hansen Way				
City	Palo Alto	State	California	Zip Code	94304
Country	USA	Telephone	(650) 856-2400	Fax	(650) 856-9299
Name (Print/Type)	Antoinette F. Konski		Registration No. (Attorney/Agent)	34,202	
Signature			Date	January 19, 2001	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any  
comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office.

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# EXHIBIT B TO DECLARATION OF ANTOINETTE F. KONSKI

PCMaster v3.04.04 - [Patent]

File Edit Records Utilities Tools Help

Baker Ref. No. 87141181-002004 Billing Attorney Working Attorney Client CHI MEI OPTOELECTRONICS, CO. Current Owner Previous Owner Client Ref. No.

Country United States Case Type Regular Relation Type Original Filing Filing Type National

DYNAMIC CMOS LEVEL-SHIFTING CIRCUIT APPARATUS

License	Addl. Priorities	Related Id	Patent Title	Text	Atty Notes	Comments
Filing Data	Related Party Info	PTO Info	Actions	Abstract	Expenses	Inventors
Action	Action Due Date	Deadline Date	Taken Date	Completed Date	Action Notes	
Info Disc. Statement	3/19/2001		3/19/2001			
Foreign filing - 6	4/19/2001		4/19/2001			
Foreign filing - 9	6/7/2001					
Foreign filing - 11	7/19/2001					
Published	9/7/2001					
Await. CC of Patent	11/7/2001					
New Application	12/7/2001					
	7/19/2002*					
				6/19/2001		
				6/22/2001	B&M San Diego	
				1/19/2001		

Created: 1/17/2001 Updated: 6/29/2001 4:18 PM By: BXC



## EXHIBIT C

### DECLARATION OF GERALD LIN

I, Gerald Lin, a citizen of R.O.C. and residing at 3F-5, No. 381, Sec. 2, Fu Hsin S. Rd. Taipei 106, Taiwan, R.O.C., declare:

1. My name is Gerald Lin and I am over the age of twenty-one (21) years, of sound mind, and fully competent to testify to the following facts. I have personal knowledge that all facts set forth in this Declaration are true and correct.
2. I am a patent engineer at the Taipei office of Baker & McKenzie, which has an address of 15<sup>th</sup> Floor, Hung Tai Center, No. 168, Tun Hwa North Road, Taipei, Taiwan 105.
3. On November 10, 2003, I received a letter from Irene Keselman of the New York office of Baker & McKenzie informing me that a Notice of Abandonment issued on October 27, 2003, for U.S. Patent Application No. 09/765,966, which has an Attorney Docket No. 87157656-002004 (the "Application"), due to failure to reply to a Notice to File Missing Parts mailed February 27, 2001 (the "Notice").
4. I have searched the file jacket of the Application and was unable to locate a copy of the Notice, which indicates that the Notice was not received by the Taipei office.
5. I further declare that all statements made herein of my own personal knowledge are true, and all statements made on information are believed to be true; and furthermore, that the statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code.

PUBLIC  
S. LEE

*Gerald Lin*

Gerald Lin

SUBSCRIBED AND SWORN TO BEFORE ME on this 24 day of December 2003, to certify which witness my hand and seal of office.

My Commission Expires:

December 31, 2011

Notary Public in and for the

State of \_\_\_\_\_

Printed Name of Notary

案號  
Case No. 00130  
日期  
Date DEC 24 2003  
本文件之簽名或蓋章，於台灣台北地方法院民間公證人處認證。  
Attested at the Notary Public of Taiwan Taipei District Court, R.O.C. that the signature(s)/seal(s) in this document is/are authentic.  
Notary Public *John S. Lee*  
公證人 李忠雄  
LEEJOHN-SHIUNG



## EXHIBIT D

### DECLARATION OF BRIAN McCORMACK

I, Brian C. McCormack, a citizen of the United States of America and residing at 5204 Meadowchase Lane, Flower Mound, Texas 75028, declare:

1. My name is Brian C. McCormack and I am over the age of twenty-one (21) years, of sound mind, and fully competent to testify to the following facts. I have personal knowledge that all facts set forth in this Declaration are true and correct.

2. I am a registered patent attorney (Reg. No. 36,601) at the firm of Baker & McKenzie at the Dallas, Texas office, which has an address of 2001 Ross Avenue, Suite 2300, Dallas, Texas 75201.

3. On November 13, 2003, the Dallas office received an inquiry from the Taipei office of Baker & McKenzie, which has an address of 15<sup>th</sup> Floor, Hung Tai Center, No. 168, Tun Hwa North Road, Taipei, Taiwan 105, regarding the filing of a Petition to Withdraw Holding of Abandonment for U.S. Patent Application No. 09/765,966, which has an Attorney Docket No. 87157656-002004 (the "Application").

4. On November 13, 2003, I began an investigation into the abandonment of the Application, and the actions available to be taken regarding this matter.

5. On December 4, 2003, I contacted Gerald Lin of the Taipei, Taiwan office of Baker & McKenzie, which has an address of 15<sup>th</sup> Floor, Hung Tai Center, No. 168, Tun Hwa North Road, Taipei, Taiwan 105, and informed him that the Dallas office would prepare the appropriate document requesting that the Application be revived or the abandonment of the Application be withdrawn.

6. Since November 13, 2003, the Dallas office has diligently pursued, without undue delay and with the cooperation of Gerald Lin, Antoinette F. Konski and June Lee, the preparation of a Petition to Withdraw Holding of Abandonment for the Application, including accompanying Declarations, until the date the Petition was filed with the United States Patent and Trademark Office.

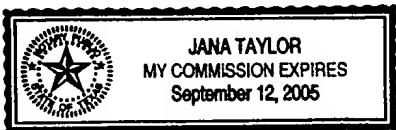
7. I further declare that all statements made herein of my own personal knowledge are true, and all statements made on information are believed to be true; and furthermore, that the statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code.

Brian C. McCormack  
Brian C. McCormack

SUBSCRIBED AND SWORN TO BEFORE ME on this 29<sup>th</sup> day of December 2003, to certify which witness my hand and seal of office.

My Commission Expires:

9/12/2005



Jana Taylor  
Notary Public in and for the  
State of Texas  
Jana Taylor  
Printed Name of Notary